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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,726	12/03/2001	David C. Schwartz	DCSBKBNDPK-C2	1315

7590  
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P.O. Box 109  
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07/21/2003

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 07/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/006,726

Applicant(s)

SCHWARTZ, DAVID C.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "said two tab closures" in lines 28-29. There is insufficient antecedent basis for this limitation in the claim.

3. Claim 1 recites the limitation "said top tab structure" in line 32. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 1 recites the limitation "said bottom tab structure" in line 33. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 26-27, it is not clear what is meant by "to said base panel along and said...".

In lines 29-30, it is not clear what is meant by "said band and said bottom end of said base panel by means...".

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman ('287) in view of Roccaforte et al. (5,503,328) and further in view of Cross ('535).

Friedman discloses a binder pocket for a ring binder having a set of perimeter features (to include opposing top and bottom height edges, opposing side width edges, a predetermined height and a predetermined width), a margin portion (the margin begin located adjacent edge inner lateral edge 28) along one of the width edges, a face surface ( top surface of 32) for receiving writing, a rectangular base panel (32) having perimeter features (to include opposing corners, opposing height edges, opposing width edges, a predetermined base panel height, and a predetermined base panel width wherein the predetermined base panel width is the pocket width), a book edge and a corner binding edge (See fig. 1); a book binding structure (26) formed along the book edge, a band (34) having predetermined height and a predetermined width, the band being closed along three sides and further having perimeter opposing top and bottom edges and opposing inner and outer edges (as seen in figure 1), a tab structure (42) formed integrally as a portion of the book binding pocket having adhesive which once the members are folded over each other automatically adheres the cover panel (34 – pocket) to the closure flap (40) (col. 4, lines 61-68); a first enclosed pocket (36) and a top corner pocket (50) for securing a plurality of loose leaf sheets; the top corner pocket having three edges including two adjacent edges attached to the base panel and an

open lip edge therebetween, and a plurality of holes (26a) set a predetermined distance from the book edge.

Regarding the attachment of the adhesive providing a permanent closure, Friedman discloses using a “cooperating adhesive means, i.e. Velcro, contact tape, or the like...”. However, Friedman fails to explicitly disclose the claimed invention except for adhesive means being a permanent closure.

Roccaforte et al. disclose a multi-use envelope comprising a front wall panel (24) having a foldably connected first closure flap (30). The first closure flap has a free edge (34), two tapered end edges (36, 37) and a permanent adhesive region (38). The permanent adhesive region enables permanent closure of the first closure flap to the front wall panel. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Friedman's invention to include a permanent closure, as taught by Roccaforte et al., to permanently attach the tab to the base panel and thus provide a secure closure therebetween resulting in an enclosed pocket.

Regarding a top and bottom tab portion adhesively attached to the base panel, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an additional tab portion adhesively attached to the base for closing the pocket, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Friedman discloses the claimed invention except for the first pocket being formed along the book edge and arranging the top corner pocket on the edge directly opposite the book binding structure. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Friedman's invention such that the first pocket is along the book edge for removably inserting sheets of paper and the top corner pocket is directly opposite the book binding structure, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Friedman discloses the claimed invention except for a bottom corner pocket opposite the book binding structure.

Cross discloses a mount comprising top and bottom corner pockets for securing the edges of inserts. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Friedman's invention to include a bottom corner pocket directly opposite the book binding structure, as taught by Cross, for securely receiving the edges of an item bound to the holder.

Note that the references to the "leaf" are not positively claimed since the leaf does not form part of the structure of the book binding pocket but is merely supported in the book binding pocket.

Regarding claim 2, see the above rejections to claim 1.

***Response to Arguments***

8. Applicant's arguments filed May 2, 2003 have been fully considered but they are not persuasive.

Applicant argues that Friedman as modified by Cross fails to teach the claimed invention. Applicant points out that the present invention is for a three ring binder and does not rely on the wire binder of Friedman for closure. Applicant states that the examiner calls Friedman a ring binder, but in fact it is a wire binder. The examiner disagrees. First, applicant never claims a three ring binder, only a ring binder ("A binder pocket for a ring binder..."). Second, Friedman, not the examiner, discloses his invention to be a "ring binder" (as seen in the first line of the ABSTRACT). Finally, ring binders and wire binders are well-known equivalent structures in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify, because these two binding structures were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a three ring binder for a wire binder. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "three ring binder") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the present invention is patentable over Friedman due to novelty, in particular, the use of a distinctly claimed Binding Region which is fundamentally different than the use and purpose of Friedman's closure structure. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the examiner maintains that the claimed structure is disclosed in the combination of the Friedman, Roccaforte et al. and Cross references as set forth in the above rejections.

Applicant argues that Friedman as modified by Cross fails to disclose any means for allowing papers to turn by releasing both diametrically opposing corners. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant states that his invention should be considered for allowance on the basis of commercial value. It is noted that commercial value is not a requirement when determining patentability.



For the reasons as set forth above, the rejections are maintained.

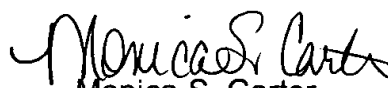
***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Welt (5,141,485) discloses a method of making a folder.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Monica S. Carter  
Primary Examiner  
Art Unit 3722

July 16, 2003